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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,634	08/15/2001	Chris W. Honsinger	82834PCW	1912

7590 08/27/2004

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EXAMINER

JOHNS, ANDREW W

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 08/27/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,634

Applicant(s)

HONSINGER ET AL.

Examiner

Andrew W. Johns

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2,3</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings filed on 15 August 2001 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-
5 948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

10 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15 Line 1 of claim 10 recites "The method of claim 9..." which is unclear and confusing because claim 9 does not recite a method. Claim 9 is directed towards "An authenticatable digital image..." so that it is unclear what method is referred to and further modified by the additional language of claim 10.

Claim Rejections - 35 U.S.C. § 101

20 4. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

25 5. Claim 9 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 9 is directed towards a digital image, which is a set of digital data or descriptive material. Such descriptive material is only statutory if it is *both* functional *and* recited as embodied on a computer-readable storage medium (M.P.E.P. § 2106). Descriptive material is considered functional if it imparts functionality on a general purpose computer system when resident therein. Computer programs and specific data structures are examples of functional descriptive material. In this case, the digital image does not impart any functionality upon a general purpose computer, so the claimed digital image is not directed towards functional descriptive material. As discussed in M.P.E.P. § 2106, non-functional descriptive material is never statutory. However, even if the digital image defined by claim 9 were considered functional, it is not recited as being embodied in a computer readable storage medium, so that the claimed image would still be considered directed towards non-statutory subject matter.

It is suggested that amending claim 9 to recite a method of creating or using the authenticatable digital image might resolve both the issue of statutory subject matter under 35 U.S.C. § 101 and the rejection of claim 10 under 35 U.S.C. § 112, second paragraph, above.

Allowable Subject Matter

6. Claims 1-8 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art teaches or suggests the claimed invention. While De Strycker et al. teaches determining a visual model of the cover image to derive a carrier for information to be embedded into the image, this analysis is performed on the *image* rather than the *receiver* on which the image is to be placed. De Strycker et al. does not suggest determining information related to a physical characteristic of the *receiver*, as required by the claims. Smith teaches determining information related to a physical characteristic of a receiver, but uses this information to generate

a hash value that is used as part of the embedded content information. Smith fails to suggest that the information related to a physical characteristic of a receiver be used to provide a carrier that is used with a second carrier that is randomly generated, as claimed. Therefore, the claimed invention is allowable over the prior art.

Conclusion

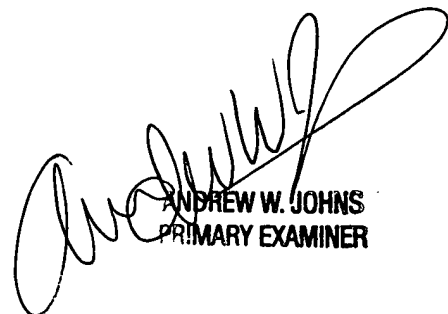
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references teach various techniques for generating carriers for content to be embedded into an image, but none teaches providing a carrier formed from information related to a physical characteristic of a receiver.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Johns whose telephone number is (703) 305-4788. The examiner is normally available Monday through Friday, at least during the hours of 9:00 am to 3:00 pm Eastern Time. The examiner may also be contacted by e-mail using the address: andrew.johns@uspto.gov. (Applicant is reminded of the Office policy regarding e-mail communications. See M.P.E.P. § 502.03)

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for this art unit is (703) 872-9306. In order to ensure prompt delivery to the examiner, all unofficial communications should be clearly labeled as "Draft" or "Unofficial."

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center Receptionist whose telephone number is (703) 305-4700.

A. Johns
18 August 2004



ANDREW W. JOHNS
PRIMARY EXAMINER